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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/010,158      | 11/13/2001  | Earl J. Votolato     | SPELL-004C          | 8649             |

7590 09/11/2002

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EXAMINER

DRUAN, THOMAS J

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                  |                   |
|------------------------------|----------------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.                  | Applicant(s)      |
|                              | 10/010,158                       | VOTOLATO, EARL J. |
|                              | Examiner<br>Thomas J. Druan, Jr. | Art Unit<br>3724  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 June 2002.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is in response to Applicant's correspondence received on 14 June 2002.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 1, lines 3-4 state that the "first and second arms are biased."

The first and second arms of the apparatus are not biased, but are resiliently connected. If claimed in a compressed state as when the arms are being urged together, then the first and second arms would be biased. However, since no such limitation is present, the claim is misleading as currently written, and therefore fails to distinctly claim the invention. Further explanation will gladly be provided over the phone at the Applicant's convenience.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

5. Claims 1 & 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen.

Chen discloses the invention as claimed including first and second arms with inner and outer surfaces, wherein said arms are in a tensioned movable opposed relationship to each other (fig. 1). Said first arm has a blade integral with the inner surface and opposing a groove in the inner surface of the second arm (fig. 3). The outer surfaces of the first and second arms are concavedly contoured (fig. 2).

***Claim Rejections - 35 USC § 103***

6. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Gilman.

Chen discloses the invention substantially as claimed, but lacks a description to tell if the invention is formed out of a single piece of material or if it includes a metal blade separate from a unitary body.

Regarding claims 4 and 5, Gilman discloses a slitting apparatus 10 with two arms 34/36 made of one piece of plastic (column 6, lines 35-38) and a blade 26 held within the inner surface of the upper arm 34 (column 5, lines 6-8). Forming the apparatus out of moldable plastic with the blade embedded therein is an inexpensive manufacturing method, and therefore it would have been obvious to make the invention of Chen with a blade embedded in a molded plastic body in order to reduce manufacturing costs. Furthermore, examiner takes Official Notice that it is old and well known in the art to use metal as a blade material due to its durability and hardness, and therefore it would have been obvious to make the blade of Gilman out of metal to have a durable, hard blade.

Regarding claims 2 and 3, the claimed embodiment is clearly anticipated because it involves no invention to form in one piece an article which has formerly been formed in two pieces and put together, as in claims 4 and 5 (see Howard v. Detroit Stove Works, 150 U.S. 164). Therefore, examiner takes Official Notice that it would have been obvious to make the slitting apparatus out of one piece since there is no inventive step beyond Chen in view of Gilman's two-piece slitting apparatus. Furthermore, examiner takes Official Notice that it would have been obvious to make the one-piece slitting apparatus out of a rigid plastic since it is well known to manufacture cutting tools out of plastics.

### ***Response to Arguments***

Applicant's arguments filed 14 June 2002 have been fully considered but they are not persuasive. Applicant contends that the cited references do not disclose or suggest a transverse laterally-open concave groove, but instead shows a convex surface.

Applicant's remarks are well taken; however, it is the examiner's position that the references anticipate and obviate the claimed invention. More specifically, Chen discloses a plastic bag opener having two resiliently connected opposing arms, one of which has a sharp triangular projection while the other has a blade tip receiver which is a transverse laterally-walled concave groove for receiving the sharp projection and a portion of the bag, as is well known in the bag-slitting art. The transverse laterally-walled concave groove is best seen in Figure 3 as a substantially rectangular cutout in the bottom arm of the device. The width of the groove is transverse to the elongation of

the arms. The convex surface referred to in the Applicant's Remarks is not the transverse laterally-walled concave groove as intended by the Examiner. Gilman is cited to teach a one-piece construction.

For the reasons above, the grounds of rejection are deemed proper.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



tjd

September 9, 2002



Allen N. Shoap  
Supervisory Patent Examiner  
Group 3700